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FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
EGWIM, KELECHI CHIDI	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/769,210
Filing Date: January 30, 2004
Appellant(s): THIES, CURT

Charles Hieken
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/05/2009 appealing from the Office action mailed 01/07/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, other the previous filing of appeals in this case as recited in appellant's Brief, none of which resulted in proceeding to the Board for a hearing.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-14 are pending and rejected in the application.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection listed under the subheading "WITHDRAWN REJECTIONS."

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

The rejection of claims 1 and 2 under 35 U.S.C. 112, second paragraph is withdrawn.

The rejection of claims 1 and 2 under 102/103 over Cohen et al. is withdrawn.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

4,997,867	JEDERSTROM ET AL.	5-1991
GB 1,454,055	--------	1-1974

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 3-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 4, from at least one of which claims 5-10 depend, provide for methods of making the beads of claim 1, but, since the claims do not set forth any steps involved in the methods/processes, it is unclear what specific methods/processes applicant is intending to encompass. A claim is indefinite where it merely recites a process without any active, positive steps delimiting the process.

Also, claims 11-14 provide for the use of the beads of claim 1, but, since the claims do not actually set forth any steps involved in the methods/processes, it is unclear what method/process steps applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

Claims 3-14 are rejected under 35 U.S.C. 101 because the claimed recitations of use/process in these claims, without setting forth any active steps involved in the processes, result in improper definitions of a process in the claims, i.e., results in claims

which are not a proper process claim under 35 U.S.C. 101. See for example Ex parte Dunki, 153 USPQ 678 (Bd.App. 1967) and Clinical Products, Ltd. v. Brenner, 255 F. Supp. 131,149 USPQ 475 (D.D.C. 1966). Claims 5-10 depend from process claims 3 or 4.

Claim Rejections - 35 USC § 102/103

Claims 1-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Jederström et al.

In col. 1, lines 10-26 and col. 3, lines 26-42, Jederström et al. teach dry polymer bead particles, comprising water-absorbent polysaccharides such as dextran, which is one of the “suitable highly water-soluble diluents” defined in applicant’s specification (see. page 4, lines 19-28).

In page 3, lines 91-96 of GB 1,454,055, explicitly incorporated by reference in Jederström et al., GB 1,454,055 teaches that the particles have a high swelling rate when in contact with water or aqueous fluids.

While Jederström et al. do not perform appellants’ specific "rapid swelling" measurements, it is reasonable that the dry polymer beads of Jederström et al. would possess the presently claimed characteristic since the dry polymer beads described in Jederström et al. are essentially the same as the actual claimed polymer beads, wherein no other structural specificity is claimed, and giving the disclosed high swelling rate when in contact with water or aqueous fluids and applicability in absorbing aqueous liquids for the polymer beads of Jederström et al. The USPTO does not have at its

disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

(10) Response to Argument

Regarding the rejection of claims 1 and 2 under 35 U.S.C. 112, second paragraph:

As indicated above, the rejections of claims 1 and 2 under 35 U.S.C. 112, second paragraph are withdrawn.

Regarding the rejection of claims 3-14 under 35 U.S.C. 112, second paragraph:

Even though the claims are interpreted in light of the specification, the claimed process must still contain at least one active step. It is impossible to determine the scope of the claimed process without any actual process steps in the claims.

Regarding the rejection of claims 3-14 under 35 U.S.C. 101:

Appellant does not provide any argument against these statutory rejections. As such, it is summarily requested that these rejections be affirmed as stated above.

Regarding the rejection of Claims 1 and 2 under 102/103 over Cohen et al.:

As indicated above, the rejection of Claims 1 and 2 under 102/103 over Cohen et al. is withdrawn.

Regarding the rejection of Claims 1-14 under 102/103 over Jederström et al:

Applicant argues that placing the beads in an aqueous solution of low molecular weight poly-lower alkylene glycol does not produce dry beads. However, it is the beads themselves that anticipate the present claims, not the aqueous solution containing the beads. The beads themselves are described as dry polymer bead particles comprising water-absorbent polysaccharides such as dextran. (In col. 1, lines 10-26 and col. 3, lines 26-42)

In response to applicants arguments, it is noted that GB 1,454,055, incorporated by reference in Jederström et al., teach that the disclosed beads, which are polymer beads of dry bead structure incorporating a compound such as dextran, consistent with applicant's classification of a diluent compound (see. page 4, lines 19-28 of present specification), are highly water-soluble characterized by "a high swelling rate when it comes into contact with water or with an aqueous fluid" (see in page 3, lines 91-96 of GB 1,454,055). It is noted that the "water-soluble diluent compound" is not and cannot functional as a diluent in the claimed dry bead products, as the beads are dry and

contain no liquid component, dilute or otherwise. Any compound contained therein would itself also be dry as part of the bead.

Regarding diffusion into the beads, as stated above, the prior art not only teaches swelling, but teaches a high swelling rate into the polymer beads. (See in page 3, lines 91-96 of GB 1,454,055, explicitly incorporated by reference in Jederström et al.)

While applicant argues that the structure of the chemically cross linked beads disclosed in the reference cannot possibly meet the limitations of the claimed invention, the have provide no data to support such a conclusion. Particularly in view of the teaching in the prior art that said high rate of swelling is achieved for the beads.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

KCE

/Dr. Kelechi C. Egwim/

Primary Examiner, Art Unit 1796

Conferees:

/James J. Seidleck/

Supervisory Patent Examiner, Art Unit 1796

/Christopher A. Fiorilla/

Chris Fiorilla

Supervisory Patent Examiner, Art Unit 1700